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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,258	04/12/2001	Carlos De La Huerga	250591.90295	3649

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QUARLES & BRADY LLP
411 E. WISCONSIN AVENUE
SUITE 2040
MILWAUKEE, WI 53202-4497

EXAMINER

LINDINGER, MICHAEL L

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,258

Applicant(s)

DE LA HUERGA, CARLOS

Examiner

Michael L. Lindinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-158 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 and 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 53-70, 100-105, and 112-129 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 53-70, 100-105, and 112-129 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the sponsor and sponsorship criteria terminology and the Claims associated or containing those words or phrases are unclear as to the structural definition of what a sponsor or sponsorship criteria is in relation to a medical container.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maestre U.S. Patent No. 5,347,453 in view of Urquhart U.S. Patent No. 4,971,221 in further view of Gombrich U.S. Patent No. 4,857,716. Regarding Claims 1-52 and 100-158, Maestra teaches an apparatus for configuring an indicating configuration to be associated with a container, wherein the apparatus includes an indicator and data stored thereon related to an enhanced memory device, wherein the apparatus is a medication container, as well as the apparatus having a processor for programming a variety of data and sub-sets of information related to a user such as patient name, medication, dosage schedule, specific instructions, wherein the apparatus is configured to be updated by a pharmacy computer system (Col. 4, lines 45+; Col. 5, lines 20+; Col. 11, lines 35+; Col. 12, lines 1+; Col. 19, lines 1+; FIG. 3A-D, 7, 8A-C, 10-11, 14). Maestre does not explicitly teach a reader for reading a descriptor and a writer for writing data to the enhanced device. The Urquhart teaches a drug dispenser having means for detecting dispensing events, wherein the device has readable signals that are interpreted by the microprocessor (Col. 4, lines 14-23; Col. 5, lines 40+; Col. 6, lines

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5+). Gombrich teaches a patient identification and verification system comprising a general purpose computer system including appropriate printer devices for printout of information such as patient identification bracelets, patient identification labels, and item identification labels for drugs (Col. 8, lines 4+; Col. 9, lines 7+; Col. 11, lines 5-12; FIG. 1-3, 11-12, 26-28). It would have been obvious to a person skilled in the art at the time of the invention to not only realize that the Maestra reference includes reading and writing means to update the enhanced device for data storing and interpreting, but to also adapt the Maestra reference to include a printing apparatus to print a label or indicating device to be located on the apparatus. Maestra demonstrates a programmable memory that is accessed by the user, and coupled with explanations from the Urquhart reference, it shows that a device such as the Maestra reference inherently possesses a reading and writing device in order to update the data that is transmitted, received, and then displayed. By providing printing capabilities to the Maestra apparatus, information can be interpreted by a handheld device quickly and efficiently.

Regarding Claims 53-99, the combined teachings of the Maestre, Urquhart, and Gombrich references inherently possess the methods of providing sub-sets of medication stored in a container including an enhanced device for storing data related to medications in the container, as well as the corresponding mounting and assembling steps needed to construct the apparatus.

Prior Art

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Schollmeyer U.S. Patent No. 4,504,153 discloses a pharmacist-programmable medication prompting system and method.
- Shepard U.S. Patent No. 4,911,327 discloses a dispenser for providing scheduled dosages of pills according to a predetermined medication program.
- Kraft U.S. Patent No. 5,213,232 discloses a rotating apparatus for dispensing single homogeneous units such as medication pills.
- Rudick U.S. Patent No. 5,289,157 discloses a medicine reminder and storage device comprising a memory for alerting users of dosage times.
- Weinberger U.S. Patent No. 5,408,443 discloses a programmable medication dispensing system including a prescribing data entry station for a physician.
- Garmaise U.S. Patent No. 5,678,925 discloses a temperature sensing and indicating beverage mug.

R sponse to Argum nts

1. Applicant's arguments filed July 1, 2003 have been fully considered but they are not persuasive. Although not a Final Response Office Action, there are issues that need to be addressed. Although the Applicant cites the differences between enhanced memory containers that are established Prior Art and his current invention, the differences are not reflected clearly in the Claims. For example, the Applicant utilizes the terms "order" and "descriptor" within the Claims frequently, however, an "order" could be construed as a pushing a button to execute an operation associated with the enhanced/smart memory containers of the Prior Art. Also, the enhanced containers, in particular the container of the Maestre reference displays a wealth of information associated with the patient including the patient name, drug name, and the frequency that the medication should be taken. These displayed characteristics are all "descriptive" features and thus, a descriptor or programmable feature must be included within an enhanced device such as the Maestre medication container. Also within the arguments, the Applicant focuses on assuming what type of actions or behavior that would influence programming or control of his medication container. These features are not only without representation in the Claims, but assuming functional use is not patentable. Regarding claims directed to attachment features, case law has been established upholding the inventive step of parts being integral with one another during a manufacturing process or assembled afterward is recognized as an equivalent apparatus.

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Conclusion

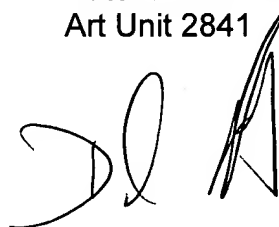
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael L. Lindinger whose telephone number is (703) 305-0618. The examiner can normally be reached on Monday-Thursday (7:30-6).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (703) 308-3121. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7318 for regular communications and (703) 746-7318 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MLL
September 22, 2003

Michael L. Lindinger
Patent Examiner
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A handwritten signature in black ink, appearing to be 'MLL', written over a horizontal line.

DAVID MARTIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800